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In re Application of :
Corredor and Stefanini :
Application No. 10/694,231 :
Filed: October 28, 2003 :
For: Beverage Bottle and Can Opener :

OFFICE OF PETITIONS

ON PETITION

This is a decision on the petition under 37 CFR 1.137(a), filed December 14, 2004, which is being treated as a petition to withdraw the holding of abandonment due to nonreceipt.¹

The petition is **dismissed**.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(a)."

Petitioner filed a petition for revival of an application for patent abandoned for unavoidable delay under 37 CFR 1.137(a). However, the Office finance records indicate that petitioner submitted a petition fee in the amount of \$55.00. The current petition fee is \$250.00. Therefore, the petition fee submitted with the present petition is insufficient in the amount of \$195.00.

The Office notes:

35 U.S.C. 41(a) (7) provides that a petition for the revival of an unintentionally abandoned application or for the unintentionally delayed payment of the issue fee must be accompanied by the petition fee set forth in 37 CFR 1.17(m), unless the petition is filed under 35 U.S.C. 133 or 151 (on the basis of unavoidable delay), in which case the fee is set forth in 37 CFR 1.17(l). Thus, unless the circumstances warrant the withdrawal of the holding of abandonment (i.e., it is determined that the application is not properly held abandoned), the payment of a petition fee to obtain the revival of an abandoned application is a statutory prerequisite to revival of the abandoned application, and cannot be waived.

In addition, the phrase "[o]n filing" in 35 U.S.C. 41(a) (7) means that the petition fee is required for the filing (and

¹The joint inventors both signed the petition and the affidavit in support of unavoidable delay.

not merely the grant) of a petition under 37 CFR 1.137. See H.R. Rep. No. 542, 97th Cong., 2d Sess. 6 (1982), reprinted in 1982 U.S.C.C.A.N. 770 ("[t]he fees set forth in this section are due on filing the petition"). Therefore, the Office: (A) will not refund the petition fee required by 37 CFR 1.17(l) or 1.17(m), regardless of whether the petition under 37 CFR 1.137 is dismissed or denied; and (B) will not reach the merits of any petition under 37 CFR 1.137 lacking the requisite petition fee.

MPEP 711.03(c) (III) (B).

Accordingly, the petition will be treated under 37 CFR 1.181 to withdraw the holding of abandonment. A petition under 37 CFR 1.181 does not require payment of a fee for a decision on the merits.

This application became abandoned for failure to reply timely to the Notice to File Missing Parts of Nonprovisional Application mailed on March 18, 2004. The Notice set a two-month extendable period to reply. No extensions of time were obtained pursuant to 37 CFR 1.136(a). Accordingly, this application became abandoned on May 19, 2004. A Notice of Abandonment was mailed on December 13, 2004.

Under 37 CFR 1.181:

Petitioner asserted that the delay was caused by nonreceipt of the Notice to File Missing Parts of Nonprovisional Application (Notice) of March 18, 2004. A review of the written record indicates no irregularity in the mailing of the Notice, and in the absence of any irregularity there is a strong presumption that the Notice was properly mailed to the petitioner at the address of record as of March 18, 2004. This presumption may be overcome by a verified showing that the Notice was not in fact received.

The showing required to establish nonreceipt of an Office communication must include a statement indicating that the Office communication was not received by petitioner and attesting to the fact that a search of petitioner's records shows that the Office communication was not received. A copy of petitioner's records where the non-received Office communication would have been entered had it been received and docketed must be attached to and referenced in the statement. See Withdrawing the Holding of Abandonment When Office Actions Are Not Received; 1156 Off. Gaz. Pat. Office 53 (November 16, 1993).

In the present petition, petitioner failed to submit a statement attesting to the fact that a search of the records indicated that the Notice to File Missing Parts was not received. Moreover, petitioner failed to provide sufficient documentary evidence such as a copy of his records to support the allegation of nonreceipt of the Notice of March 18, 2004.

Accordingly, the petition under 37 CFR 1.181 is **dismissed**.

Alternate Venue:

Petitioner may wish to consider filing a petition under 37 CFR 1.137(b). The Office further notes:

Petitions under 37 CFR 1.137(b) are less burdensome (statement(s) rather than a showing accompanied by documentary evidence) to file and are evaluated under the less stringent "unintentional delay" standard. Applicants determining whether to file a petition to revive an application under 37 CFR 1.137(b) or 1.137(a) should take the following into account: While the Office reserves the authority to require further information concerning the cause of abandonment and delay in filing a petition to revive, the Office relies upon the applicant's duty of candor and good faith and accepts the statement that "the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional" without requiring further information in the vast majority of petitions under 37 CFR 1.137(b). This is because the applicant is obligated under 37 CFR 10.18 to inquire into the underlying facts and circumstances when a practitioner provides this statement to the Office. In addition, providing an inappropriate statement in a petition under 37 CFR 1.137(b) to revive an abandoned application may have an adverse effect when attempting to enforce any patent resulting from the application. See *Lumenyte Int'l Corp. v. Cable Lite Corp.*, Nos. 96-1011, 96-1077, 1996 U.S. App. LEXIS 16400, 1996 WL 383927 (Fed. Cir. July 9, 1996) (unpublished) (patents held unenforceable due to a finding of inequitable conduct in submitting an inappropriate statement that the abandonment was unintentional). Even if the Office requires further information in a petition under 37 CFR 1.137(b), such petition is still significantly less burdensome to prepare and prosecute than a petition under 37 CFR 1.137(a). The Office is almost always satisfied as to whether "the entire delay...was unintentional" on the basis of statement(s) by the applicant or representative explaining the cause of the delay (accompanied at most by copies of correspondence relevant to the period of delay). A showing of unavoidable delay will (in addition to the above) require: (1) evidence concerning the procedures in place that should have avoided the error resulting in the delay; (2) evidence concerning the training and experience of the persons responsible for the error; and (3) copies of any applicable docketing records to show that the error was in fact the cause of the delay. See MPEP § 711.03(c)(III)(C)(2). In addition, a petition under 37 CFR 1.137(a) must establish that the delay was unavoidable, and not just that it was unintentional. Thus, many petitions originally filed under 37 CFR 1.137(a) end up being granted under 37 CFR 1.137(b) when the applicant realizes that sufficient evidence concerning the delay is too difficult to obtain or the cause of delay simply does not amount to "unavoidable delay" within the meaning of 37 CFR 1.137(a). Since the requirements of 37 CFR 1.137(a) are more exacting than the corresponding requirements of 37 CFR 1.137(b), a petition under 37 CFR 1.137(a) is significantly less likely to be grantable as filed than is a petition under 37 CFR 1.137(b). The Office usually must render a number of interlocutory decisions dismissing a petition under 37 CFR 1.137(a) and requesting additional evidence until either the applicant provides a satisfactory showing of unavoidable delay (in which case the petition can be granted) or the Office concludes that the applicant cannot provide a

satisfactory showing of unavoidable delay (in which case the petition must be denied). Thus, the period between when an applicant first files a petition to revive and the Office renders a decision granting (or denying) that petition will, more often than not, be much longer if the petition is under 37 CFR 1.137(a) than it would have been if the petition were under 37 CFR 1.137(b). 37 CFR 1.137(b) now provides that where the delay in reply was unintentional, a petition may be filed to revive an abandoned application or a lapsed patent pursuant to 37 CFR 1.137(b).

MPEP 711.03(c)(III)(C).

A grantable petition pursuant to 37 CFR 1.137(b) must be accompanied by:

(1) The required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof;

(2) **The petition fee as set forth in § 1.17(m) in the amount of \$750.00;**

(3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional; and

(4) Any terminal disclaimer (and fee as set forth in § 1.20(d)) required pursuant to 37 CFR 1.137(c).

For petitioner's convenience, a form for filing a petition under 37 CFR 1.137(b) is enclosed, as well as a copy of the Notice to File Missing Parts. Petitioner may wish to apply the \$55.00 petition fee paid on December 14, 2004, towards the petition fee for a renewed petition under 37 CFR 1.137(a) or a petition under 37 CFR 1.137(b).

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petition
 Commissioner for Patents
 P.O. Box 1450
 Alexandria, VA 22313-1450

By FAX: (703) 872-9306
 Attn: Office of Petitions

By hand: Customer Service Window
 Randolph Building
 401 Dulany Street
 Alexandria, VA 22314

Telephone inquiries should be directed to the undersigned at (571) 272-3211.

Christina Tartera Donnell

Christina Tartera Donnell
Senior Petitions Attorney
Office of Petitions

Enclosures: PTO/SB/64 - Petition For Revival Of An Application For Patent Abandoned Unintentionally; Notice to File Missing Parts in a Nonprovisional Application dated March 18, 2004.